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REMARKS

In the Office Action, the Examiner indicated that claims 1, 3-11 and 13 are pending in the application and the Examiner rejected all claims. Applicant wishes to thank the Examiner for discussing the claims during a teleconference conducted on August 3, 2005. Applicant has amended the claims herein based on the substance of the discussions during the teleconference.

Claim Rejections, 35 U.S.C. §102

In item 4 on page 3 of the Office Action, the Examiner rejected claim 9 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,121,968 to Arcuri et al. ("Arcuri").

Rejection of Claims 1, 3-8, 10, 11 and 13 under 35 U.S.C. §103(a)

On page 4 of the Office Action, the Examiner rejected claims 1, 3-8, 10, 11 and 13 under 35 U.S.C. §103(a) as being unpatentable over Arcuri.

The Present Invention

The present invention is a customizable "hot list" used in connection with drop-down list boxes on web-based forms. The user can select, manually, which items are to be included in the customizable hot list. The customizable hot list appears on the user's screen when activated, e.g., when a drop-down list box is clicked with the right mouse button. This hot list presents a subset of the items contained within the drop-down list box, as selected by the user. The content of the

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hot list is determined manually, entirely by the user, via configuration of a "Preferences" menu option.

U.S. Patent No. 6,121,968 to Arcuri et al.

U.S. Patent No. 6,121,968 to Arcuri et al. ("Arcuri") teaches a two-state drop-down menu comprising a short menu state and a long menu state. The short menu comprises a list of executable commands which are a subset of the total number of executable commands available under the selected menu. The short menu may be dynamically expanded into a long menu which will contain a list of the complete set of executable commands available under the selected menu.

The short menu adapts to the personal needs of the user, based upon the user's use (or lack thereof) of the executable commands available. Thus, the selection of an executable command for execution automatically places that executable command on the short list (or maintains it on the list if it was there already), where it remains for a period of time associated with continued use of the selected executable command relative to the operation of the drop-down menus themselves.

The Cited Prior Art Does Not Anticipate the Claimed Invention

The MPEP and case law provide the following definition of anticipation for the purposes of 35 U.S.C. §102:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."
MPEP §2131 citing *Verdegaal Bros. v. Union Oil Company of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987).

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Independent claims 1, 9, 11, and 13 have each been amended to require that "the items to be included in said subset of items are manually selectable by a user of said GUI". In other words, in accordance with each of the independent claims, the user manually selects which items will appear in the customizable hot list. This element is neither taught nor suggested by Arcuri. Arcuri merely teaches the automatic inclusion of items on the list based upon use of the executable command by the user. This results in a different functionality than the present invention. For example, using the Arcuri system, if a user selects an item to activate a particular program, and finds the program to be inadequate for the needs of the user, that undesired item will automatically appear in the short menu even though the user has no interest in using that item again. By contrast, by enabling and allowing the user to manually select the items to appear in the hot list, the user has the ability to add or delete programs as desired, including in an initial set up of the system when first using the program containing the hot lists. As described in Arcuri, only the developer has the ability to set the default lists, and thereafter, additions to the short list are only made by actually activating an executable command from the list of available executable commands.

Since Arcuri does not teach or suggest this feature, and since this feature is specifically claimed in claim 9, it is submitted that a rejection of claim 9 under 35 U.S.C. §102 based upon Arcuri is inappropriate. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of claim 9 under 35 U.S.C. §102.

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The Examiner has not Established a *prima facie* Case of Obviousness

As set forth in the MPEP:

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skilled in the art, to modify the reference or to combine reference teachings.

MPEP 2143

As noted above, Arcuri contains no teaching or suggestion of manual user selection of items to appear in a hot list or, in the parlance of Arcuri, a short list menu. Without such teaching or suggestion, any claims containing this element patentably define over Arcuri. In accordance with this amendment, each of the independent claims incorporate specifically the manual selectability of items displayed in the hot list by the user. Accordingly, each of the independent claims and all claims depending therefrom, patentably define over Arcuri and are in condition for allowance.

Conclusion

The present invention is not taught or suggested by the prior art. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of the claims. An early Notice of Allowance is earnestly solicited.

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Enclosed herewith is a Request for Continued Examination (RCE). The Commissioner is hereby authorized to charge any additional fees or credit any overpayment associated with this communication to Deposit Account No. 09-0461.

Respectfully submitted,

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Date


Mark D. Simpson, Esquire
Registration No. 32,942

SYNNESTVEDT & LECHNER LLP
2600 ARAMARK Tower
1101 Market Street
Philadelphia, PA 19107

Telephone: (215) 923-4466
Facsimile: (215) 923-2189

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